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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,404	12/01/2000	Satoshi Nishikawa	862.C2066	1364

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EXAMINER
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QIN, YIXING

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/726,404

Applicant(s)

NISHIKAWA, SATOSHI

Examiner

Yixing Qin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-11 and 27-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-11 and 27-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2000 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.                                                |

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## **DETAILED ACTION**

### ***Response to Amendment***

In response to applicant's amendment received 10/17/05 all requested changes have been entered.

### ***Response to Arguments***

Applicant's arguments filed 10/17/05 have been fully considered but they are not persuasive. The first argument made is that the control apparatus works as a host computer of the printing apparatus. Although the control apparatus is in the printer in the Shima reference, the capabilities of the control mechanism in the Shima reference are very similar to the capabilities of the control mechanism in the computer of the applicant's invention. The Examiner believes that the location of the spooler is a matter of design since the inclusion of spoolers in either a computer or a printer is well-known in the art.

The second argument is that the Shima reference discloses that if not enough memory is available, then there would not be a way to perform printing of the rest of the copies of a multiple copy job. While Shima does say this, this is only one of the conditions possible in the Shima invention (i.e. condition (1) from column 11, lines 6-24). Immediately below this is condition (2), another condition in which there is sufficient memory. Furthermore, Figs. 13 and 14 shows printing of a first page or copy before printing the rest of the pages or copies. Please see the rejection below.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I. Claims 6-9, 11, 27-30, 32-35, and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima et al (U.S. Patent No. 6,104,498).

**1. Claims 6, 27, 32, and 37**

- Shima et al discloses in column 2, lines 32-38 discloses that a computer (i.e. **print control apparatus**) can send M copies of pages to a printer. This is essentially a queue of pages that gets sent to the printer. This is analogous to a spooler, which is basically a queue storage mechanism. Please also note Yoneda (US Patent No. 6,147,765 - Fig. 9, column 4, lines 21-22) and Fall et al (US Patent No. 5,764,863 - column 2, lines 22-25) for further support that copies and data can be saved to a spooler.
- Shima discloses in Figs. 13 and 14 and column 14, lines 5-29 the flow that takes place for performing a test print. It would be obvious that the data and the number of copies would be stored together. Fig. 12, item S59 discloses the checking of a test print. Although Shima does not call the program that executes this flow a "spool file manager," the spool file manager is that is being claimed is only a program that performs certain functions, which are disclosed by the Shima reference as noted above.
- Shima discloses in column 14, lines 7-10 that intermediate data is converted into print data (i.e. image) to be printed by the print management task 74. One can interpret this to be the generation unit.
- Again, from Figs. 13 and 14 one can see that a test print is performed and 1 copy is printed and then M-1 (where M is the total number of copies) are then printed when the test print if Ok.

**2. Claims 7, 28, 33, and 38**

- Shima et al discloses in fig. 9 and column 10, lines 1-3, that 'If the number of copies is reached, all information read from the storage means and printed is deleted from the storage means at step S39.' This claim is analyzed in a similar fashion as the previously rejected, and currently canceled, claim 2.

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**3. Claims 8, 29, 34 and 39**

- Shima et al discloses in fig. 13 and column 14, lines 13-15, that "If the test print is OK, print of the second page to the Pth page is executed at steps S74-S77. Next, the remaining (M-1) copies are printed at steps S78-S83." The M that Shima et al refers to a register that keeps track of the number of copies the job has. The point is that Shima et al is reducing the number of copies left to print since the test copy can simply be used as one of the copies that is needed. Although it is not explicitly disclosed that it is the print management task that keeps track of the number of copies, it would be obvious that it could perform this function.

**4. Claims 9, 30, 35, and 40**

- Shima et al discloses in column 3, lines 28-5 that "...format conversion means for converting a format of the print information to prepare intermediate print information, means for storing the data and the intermediate print information..." and "...the storage means consists of a RAM and auxiliary storage means ..." In regards to the "...change step of changing the setup associated...", Shima et al discloses in column 3, lines 18-23, that their invention "...enables[s] print specifications to be changed even after print information is transmitted..." The idea behind Shima et al's statement is that there is no need to retransmit information; it can simply be changed "on the fly."

**5. Claim 11**

- Shima discloses in column 1, lines 11-13 that a host computer can output data to a printer.

II. Claims 10, 31, 36 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima et al (U.S. Patent No. 6,104,498) in view of Williams et al (U.S. Patent No. 5,237,923).

**6. Claims 10, 31, 36 and 41**

- the Shima et al reference discloses all the limitations of claim 5 except for "...the step of resetting the designated number of sets of copies..." The secondary reference by Williams et al teaches in column 8, lines 61-68 and column 9 line 3, the printing of "proof copies of the original document, the number being determined by the operator's instructions entered via keyboard..." and when "...acceptable, the operator can instruct the press to print the required number of final copies." Also, Williams et al takes into account that "[i]f changes are required, new printing plates can be made..." The point here is that Williams et

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al's reference accounts for changes in "proof" (test) copies and the ability to change the number of copies to any value based on user input. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a step of resetting the number of copies to a designated value when test printing is involved as taught by the Williams et al reference in light of the Shima et al invention. The motivation is to be able to print the appropriate number of copies if the test print is deemed to be acceptable.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YQ

  
EDWARD COLES  
SUPERVISOR